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10/747,605

12/29/2003

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04/30/2008

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EXAMINER

BUI PHO, PASCAL M

ART UNIT

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2878

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DELIVERY MODE

04/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/747,605 | Applicant(s) BRICKEY ET AL. | |
| | Examiner Pascal M. Bui-Pho | Art Unit 2878 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,7,10,14,15 and 18 is/are rejected.
- 7) ☒ Claim(s) 2-6,8,9,13,16,17 and 19-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is responsive to communications filed on 09 January 2008. Presently, Claims 1-10 and 13-29 remain pending. Upon further consideration, the previously cited Gordon et al. reference (US 5,432,339) is found to anticipate the rejected claims found below. In order to further expedite prosecution, a response to the arguments filed on 05 June 2007 in the Pre-Appeal Brief follows. Examiner extends apologies for any inconvenience this may cause.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 7, 10, 15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Gordon et al. (US 5,432,339).

With regards to Claims 1, 7, 10, 15, and 18, Gordon et al. disclose in Fig. 1 a timing device comprising: an indicator device in a disk (arcuate shape) and a detector (42, 44, 50, 52) comprising more than one sensor wherein said indicator device (36, 40) comprises the combination of a pulsating light-emissive element (36) and a patterning layer (40) patterned with a timing device encoder pattern wherein said indicator device moves relative to said detector.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (US 5,432,339).

With regards to Claim 14, Gordon et al. disclose in Fig. 1 the device set forth above, but lack a clear inclusion of light focusing or directing lenses. Selecting known available optics to obtain greater control of the modulation of light would have been obvious to one of ordinary skill in the art. Accordingly, at the time of the invention it would have been obvious to modify Gordon et al. by including light focusing or directing lenses in order to provide more reliable sensing results.

Allowable Subject Matter

5. Claims 2-6, 8, 9, 13, 16, 17, and 19-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments, see Pages 3-6, filed 09 January 2008, with respect to Claims 1-10 and 13-29 have been fully considered and are persuasive. The rejection of Claims 1-10 and 13-29 with respect to Chin et al. (US 6,653,619) has been withdrawn.

In the Pre-Appeal Brief filed on 05 June 2007, Applicant sets forth the following arguments with respect to Gordon et al. (US 5,432,339):

A) On Page 2, "There is no support for the Examiner's characterization of X-ray source 36 and X-ray detector array 38 as being part of a timing device. To the contrary, such elements are clearly only disclosed as being part of a described X-ray tomography imaging system, and do

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not constitute part of any timing device which may be employed therewith. Significantly, each of elements 36 and 38 are provided in fixed relative locations on disk 38, and thus do not move relative to each other, and accordingly cannot function as a timing device.”

Response: Examiner respectfully disagrees and directs Applicant to the above rejection for further clarification. Examiner respectfully notes that the claimed "indicator device" is anticipated by elements 36 and 40 of Gordon et al, not elements 36 and 38. The indicator device (36, 40) taught by Gordon et al. moves relative to detector (42, 44, 50, 52). As presently claimed, there is no functional relationship between the indicator device and the detector, barring the claimed relative motion. More specifically, no claim language recites the claimed detector detecting/receiving light from the claimed indicator device. As presently claimed, there is no preclusion for the timing device from comprising the indicator device (36, 40) and detector (42, 44, 50, 52) taught by Gordon et al. Accordingly, the rejection set forth is deemed proper.

B) On Page 2, “Markers 40 of Gordon et al are also disposed on disk 28, and they also are not employed in combination with X-ray source 36 so as for such combination to function as a timing device as alleged by the Examiner.”

Response: Examiner respectfully disagrees and directs Applicant to the Response set forth with respect to Argument A) above. As stated above, no claim language has been found defining the function of the claimed timing device. As broadly and reasonably understood, Applicant merely claims a timing device comprising an indicator device and a detector, wherein said indicator device moves relative to the detector. Such limitation is anticipated as explained above. No limitation cites, among other functions, the claimed detector detecting/receiving light from the claimed indicator. Accordingly, the rejection set forth is deemed proper.

C) On Page 2, “Such combination [of element 40 with elements 42 44, 50, and 52], however, does not comprise an indicator device in accordance with the present claimed invention, as there is clearly no teaching in Gordon et al. to employ a light emitting element as part of an indicating device of a timing device. Again, X-ray source 36 is not in any way disclosed as being capable of functioning as part of an indicator device component of a timing device as alleged by the Examiner. ”

Response: Examiner respectfully disagrees. Firstly, one of ordinary skill in the art would recognize X-ray as being part of the electromagnetic spectrum, hence considered light. Any element that emits x-ray is considered light emitting. In at least Claim 1, no limitation cites the light emitting element as emitting *visible* light, as Applicant appears to allege. Secondly, Examiner directs Applicant to the responses set forth with respect to Arguments A) and B) wherein it is emphasized that no functional relationship has been claimed between the claimed indicator device and the claimed detector. As broadly and reasonably understood, a timing device can comprise an indicator device comprising the combination of a light-emissive element and a patterning layer and a detector, but the detector does not inherently detect light emitted by said element. Accordingly, the rejection set forth is deemed proper.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Pascal M. Bui-Pho whose telephone number is (571)272-2714. The Examiner can normally be reached on Monday through Friday: 8:30 a.m. - 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the

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organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pascal M. Bui-Pho
Examiner, Art Unit 2878
25 April 2008

/Thanh X Luu/
Primary Examiner, Art Unit 2878